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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,748	06/29/2001	Gary B. Robinson	16113-1342RE2	3348
26192 7590 10/20/2011 FISH & RICHARDSON P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022				
EXAMINER RETTA, YEHDEGA				
ART UNIT 3622		PAPER NUMBER		
NOTIFICATION DATE 10/20/2011		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Office Action Summary**Application No.**

09/893,748

Applicant(s)

ROBINSON, GARY B.

Examiner

YEHDEGA RETTA

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 1-37,39-41 and 48-50 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☐ Claim(s) ____ is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☒ Claim(s) 1-37,39-41 and 48-50 are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-813)
Paper No(s)/Mail Date: ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

This office action is in response to Election/Restriction filed July 7, 2011. Applicant elected Group I (claims 1-25 and 26-41). However claim 38 is a cancelled claim. A second restriction is made in order to correct the mistake made in the previous restriction.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims **1-25, 26-37, 39-41**, drawn to determining subject's community and *displaying a new advertisement to determine if whether a high a low proportion of the community respond to the advertisement*, classified in class 705, subclass 14. 66.
- II. Claim 42, drawn to sending advertisements to users that belong to a community and *not to a subset of users which belong to the community (not in the defined subset)*, classified in class 705, subclass 14.4.
- III. Claims 43-44, drawn to tracking ad selections and defining probabilities for ad selection in the community, classified in class 705, subclass 14. 52.
- IV. Claims 45-47, drawn to requesting an identified ad not be shown, classified in class 705, subclass 14.6.
- V. Claim 48 drawn to advertisement rejection and replacement, classified in class 705, subclass 14.55.
- VI. Claim 49 drawn to receiving at user computer advertisement criteria and deciding at the user's computer, if an advertisement is to be shown based on the criteria, classified in class 705, subclass 14.53.

VII. Claims 51-52, drawn to receipt of info about page activity where the page refers to a central database, classified in class 705, subclass 29.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II-VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination IV has separate utility such as *determining a community of a subject and displaying a new advertisement for a training period to determine whether a high or a low proportion of the community have viewed further information about the advertisement*. See MPEP § 806.05(d).

Inventions II and I, III-VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination II has separate utility such as sending an advertisement associated with an attribute to users that belong to community which do not belong to a subset of users which are described by the attribute. See MPEP § 806.05(d).

Inventions III and I, II, IV-VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is

separately usable. In the instant case, subcombination III has separate utility such as determining a probability with which a randomly chosen members of said community will select an advertisement that was sent to a plurality of users. See MPEP § 806.05(d).

Inventions IV and I-III, V-VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination IV has separate utility such as refraining from showing advertisement in connection with interactive medium item. See MPEP § 806.05(d).

Inventions V and I-IV, VI, VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination V has separate utility such as replacing a first advertisement with second advertisement when a user rejects the first advertisement. See MPEP § 806.05(d).

Inventions VI and I-V, VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination VI has separate utility such as deciding at a user computer if an advertisement is to be shown at said user computer based upon said information and advertisement criteria. See MPEP § 806.05(d).

Inventions VII and I-VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination VII has separate utility such as gathering information at a central database based upon activity of a user with respect to a webpage. See MPEP § 806.05(d).

Since applicant independently claims the inventions of the groups, it is a prima facie showing that the inventions are intended to be independent and distinct and are shown to be separately usable.

Applicant in response to the restriction requirement made in the action mailed October 8, 2009, stated because identified groups 1 and 2 each include original claims, restriction between the identified claims should not be made. However examiner does not agree with applicant since the claims in Group II to Group VII (i.e. claims 42-52) do not include original claims. Therefore, restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and/or examination burden if restriction were not required.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be

considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to YEHDEGA RETTA whose telephone number is (571)272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR
/Yehdega Retta/
Primary Examiner, Art Unit 3622